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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91191698
Party	Plaintiff McDonald's Corporation
Correspondence Address	John A Cullis Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, jcullis@ngelaw.com, mturner@ngelaw.com, rbrowne@ngelaw.com, mbenson@ngelaw.com
Submission	Motion to Strike
Filer's Name	John A. Cullis
Filer's e-mail	jcullis@ngelaw.com, mturner@ngelaw.com, apeterson@ngelaw.com
Signature	/John A. Cullis/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

McDONALD'S CORPORATION,	)	
	)	
Opposer,	)	Opposition No. 91/191,698
	)	
v.	)	
	)	Serial No. 77/650,095
LANCE R. KAUFMAN,	)	
	)	Mark: McPHONE
Applicant.	)	

Opposer's Motion to Strike Portions of Applicant's Answer

Opposer, McDonald's Corporation ("Opposer"), pursuant to Federal Rule of Civil Procedure 12(f) and TBMP §506, hereby moves this Board for an order striking certain portions of the pleading filed by Applicant, Lance R. Kaufman ("Applicant"), as his Answer in this matter. In support of this motion, Opposer states as follows:

1. On August 28, 2009, Opposer initiated this proceeding against Applicant, opposing registration of Serial No. 77/650,095 for the mark "McPHONE" for use in connection with mobile communication devices, magnetically encoded cards, and numerous other goods in International Class 9 (the "McPHONE Mark") on the grounds that Applicant's use of the McPHONE Mark is likely to both cause confusion with and dilute Opposer's family of "Mc" formative marks, as defined in its Notice of Opposition.

2. On September 14, 2009, Applicant filed a response, which the Board has deemed his Answer, a copy of which is attached hereto as Exhibit A.[1] Applicant's Answer fails to follow a number of Trademark Rules, such as Rule 2.126 regarding form of submissions and Rule 2.193 requiring that the Answer be properly signed. More importantly, the Answer fails on substantive

[1] Applicant did not serve a copy of his Answer on Opposer as required by Trademark Rule 2.119(a). Recognizing this, the Board furnished Opposer a copy by way of its Order of October 1, 2009. Accordingly, the time for this Motion to Strike runs from October 1, 2009, and it is being timely filed within the permissible fifteen day period.

grounds. "An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies." 37 C.F.R. § 2.106(b)(1); *see also* Fed. R. Civ. Proc. 8(b). Using the answer to "argue the merits of the allegations" is not proper and does not put the opposer on notice as to the applicant's defenses, if any. TBMP § 311.02(a). Applicant's Answer responds with argument to each of the fifteen allegations set forth in Opposer's Notice of Opposition. Much of this argument is unnecessary clutter that is either irrelevant, legally unsupportable, pure conjecture, or simply not understandable.[2]

3. "[When] motions to strike remove unnecessary clutter from the case, they serve to expedite, not delay." *United States v. Fairchild Indus., Inc.*, 766 F. Supp. 405, 408 (D. Md. 1991). Moreover, material set forth in an answer "that might confuse the issues in the case and would not, under the facts alleged, constitute a valid defense to the action can and should be deleted." 5A WRIGHT AND MILLER § 1381 at 665.

4. An example of such unnecessary clutter is Applicant's argument that his application is for "MCPhone" and not "McPhone" or "McPHONE" – an argument that is repeated throughout Applicant's Answer. Applicant uses this argument in response to eleven of the fifteen numbered paragraphs in Opposer's Notice of Opposition. Applicant has applied for a standard character mark as described in TMEP § 807.03. Thus, should his application be allowed to register, Applicant would have the right to use any of "MCPhone," "McPhone," OR "McPHONE," and could prevent others from doing the same. Applicant's representation that his intent is to only use "MCPhone" and not "McPhone" or "McPHONE" is neither binding on Applicant nor relevant in this proceeding. Accordingly, all of Applicant's arguments based on the premise that Opposer is opposing a mark (*i.e.*, "McPHONE" or "McPhone") that Applicant

[2] While Opposer recognizes that Applicant has thus far acted pro se, Opposer's rights are at issue in this proceeding, and it appreciates the Interlocutory Attorney's recognition in her Order of October 1, 2009, that strict compliance with the rules will be required regardless of Applicant's choice of counsel.

has not applied for are unnecessary clutter that should be stricken. This argument is the sole basis for Applicant's entire response to Notice of Opposition paragraph numbers 7, 11, 12, 14 and 15. In addition, when this argument is removed from Applicant's responses to Notice of Opposition paragraph numbers 6 and 13, the remainder of those responses consist of meaningless, irrelevant and incorrect statements that must also be stricken.[3] To the extent this leaves Opposer's allegations of paragraphs 6, 7, 11, 12, 13, 14 and 15 of its Notice of Opposition unanswered, these allegations should be deemed admitted.

5. In paragraph 3, Applicant alleges that certain businesses unrelated to this proceeding "operate independently without any cross confusion." While Applicant's point with this statement is unclear, there is no evidence given to support it. Accordingly, it is merely a "bare bones conclusory allegation" which does not belong in an answer and should be stricken. *See Heller Financial, Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294-95 (7th Cir. 1989).

6. In paragraph 8, Applicant appears to be denying that confusion between "McPhone" and Opposer's "Mc" family of marks is likely. In doing so, he makes reference to the mark "McCurry," and its use in a foreign country. Foreign use of a mark has no bearing on rights within the United States. *See Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990). The "McCurry" mark is not registered in the United States, and Applicant does not allege that it has ever been used in this country. Accordingly, it is irrelevant and all references to it should be stricken.

7. Finally, in his concluding paragraph, Applicant pleads his "opinion" that his mark "is in no way related to McDonald's allegations." Though parties to an opposition undoubtedly

[3] Response paragraph 6 would be left with a reference to "specific copyright rules" which is not understandable and response paragraph 13 would be left with the incorrect statement that "hundreds of other companies [have been] issued "Mc" as a stand alone mark or as part of a "Mc" prefix."

will have differing opinions, the only opinion that is relevant is that of the Board. Applicant's opinion in this context is merely and unsupported assertion that should be stricken.

8. In sum, the contents of paragraphs 6, 7, 11, 12, 13, 14 and 15 of Applicant's Answer should be stricken from this case in their entirety. Furthermore, the improper portion of paragraph 8 described above should also be stricken. These identified responses are all either irrelevant, incoherent, or legally unsupportable as set forth above. Removing this material will best serve the interests of the parties and the Board by removing irrelevant and unnecessary issues from the proceeding and allowing this case to move forward in an efficient and focused manner.

WHEREFORE, Opposer respectfully requests that the Board enter an Order granting its Motion and:

1. striking the portions of Applicant's Answer set forth herein; and
2. granting Opposer any such additional and further relief that the Board deems proper.

Respectfully submitted,

Date: October 16, 2009

By: / John A. Cullis/

One of the Attorneys for Opposer,
McDonald's Corporation
Robert E. Browne
John A. Cullis
Mike R. Turner
NEAL, GERBER & EISENBERG LLP
Two North LaSalle Street, Suite 2200
Chicago, IL 60602-3801

CERTIFICATE OF TRANSMISSION

I, Mike R. Turner, hereby certify that the foregoing ***Opposer's Motion to Strike Portions of Applicant's Answer*** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at http://estta.uspto.gov/ on the date noted below:

Date: October 16, 2009

By: / Mike R. Turner/
One of the Attorneys for McDonald's Corporation

Robert E. Browne
John A. Cullis
Mike R. Turner
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 1700
Chicago, Illinois 60602-3801
(312) 269-8000

CERTIFICATE OF SERVICE

I, Mike R. Turner, state that I served a copy of the foregoing ***Opposer's Motion to Strike Portions of Applicant's Answer*** upon the Applicant for Application Serial No. 77/650,095 at his address of record as listed with the USPTO:

Lance R. Kaufman
10888 E. Karen Dr.
Scottsdale, AZ 85255-1817

via First Class Mail in accordance with Trademark Rule §§ 2.201 and 2.119 on this 16th day of October, 2009.

/Mike R. Turner /
Mike R. Turner

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